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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,020	01/29/2002	Terence Edward Sumner	113041.125	4941
23483	7590	10/26/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			HO, DUC CHI	
60 STATE STREET			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	
			2665	
DATE MAILED: 10/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/060,020	Applicant(s) SUMNER ET AL.	
	Examiner Duc C. Ho	Art Unit 2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Acknowledgement

1. The document listed on the form 1449 consists of four documents has been received on April 02, 2002. However, the pertinent article "New advance billing for 3G wireless, 3G HOME, cccc FREE Daily 3G Newsletter, January 21 2002" is not submitted for consideration. Please include this document when sending in a response for this Office Action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ala-Laurila et al. (US 6,477,156), hereinafter referred to as Laurila.

Regarding claim 1, Laurila discloses apparatus and associated method for selectably operating radio device in alternate operating mode.

identifying access information for a wireless local area network, the access information being accessible over a wireless packet data connection; and

based on the access information, establishing a connection between a wireless device and the WLAN (the mobile terminal 12-fig. 1 based on the access point list 38 is capable of identifying access information of a WLAN for establishing a connection, see col. 6, lines 10-36).

Regarding claim 2, the mobile terminal 12-fig. 1 is capable of receiving data from a wireless WAN via the external communication network backbone 24-fig.1 and from the WLAN 14, see col. 5, lines 8-16.

Regarding claims 3-4, the communication in system 1 is capable of having connections that includes a narrowband packet data connection, that is compatible with narrowband paging technology.

Regarding claim 5, this claim has similar limitations as claim 1. Therefore, it is rejected under Ala for the same reasons set forth in the rejection of claim 1.

Regarding claim 15, this claim has similar limitations as claim 1. Therefore, it is rejected under Ala for the same reasons set forth in the rejection of claim 1.

Regarding claim 19, this claim has similar limitations as claim 1. Therefore, it is rejected under Ala for the same reasons set forth in the rejection of claim 1. The mode selector 34-fig.1 is a connection establishing mechanism.

Regarding claim 20, this claim has similar limitations as claim 1. Therefore, it is rejected under Ala for the same reasons set forth in the rejection of claim 1. The mobile terminal block 28'-fig. 1 inherently includes software to implement steps identifying the WLAN and establishing the connection.

Regarding claim 16, the mobile terminal 12-fig. 1 is capable of receiving data from a wireless WAN via the external communication network backbone 24-fig.1 and from the WLAN 14, see col. 5, lines 8-16.

Regarding claims 17-18, the communication in system 1 is capable of having connections that includes a narrowband packet data connection, that is compatible with narrowband paging technology.

4. Claims 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Eaton et al. (US 6,888,811), hereinafter referred to as Eaton.

Regarding claim 6, Eaton discloses communication system for location sensitive information and method therefor.

identifying location information pertaining to a geographical location (the device 100-fig. 1 can request location information via the WAN transceiver 104 to the WAN communication system 116-fig. 2 for a listing of, i.e. restaurants, see col. 7, lines 16-42); and

based on a communication over a WWAN, identifying a WLAN that corresponds to the location information (Based on the provided information, the device 100 can inherently communicates with WLAN114-fig. 2 to reach the restaurant).

Regarding claim 7, Eaton discloses communication system for location sensitive information and method therefor.

identifying a wireless device and a wireless local area network (since the SNAP 130-fig.3 is a bridge between WLAN114-fig.1 and WAN 116-fig.1, it is able to identify a wireless device 132-fig. 3 or the portable 100 and a WLAN114-fig.3, see col. 9-line 48 to col. 10-line 65, see col. 11, lines 28-46); and

conveying information via a wireless packet data connection to the wireless device sufficient to enable the wireless device to detect the WLAN (if the portable 100-fig. 3 is allowed on WLAN 114-fig. 3, the SNAP 130 sends the location data to the device 100, see col. 12, lines 18-36, step 170-fig.4);

sending information to a control point of the WLAN sufficient to authorize the wireless device to utilize a service through the WLAN (the SNAP130-fig.3 can communicate with the

processor 156-fig. 3 to authorize the portable device 100 to have a service through the WLAN114, see col. 11, lines 28-46).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton, in view of Juha Ala-Laurila et al. (Wireless LAN access network Architecture for wireless devices, EE time, Dec,5 2001-IDS), here in after referred to as Laurila.

Regarding claim 8, Eaton discloses all claimed limitation, except the wireless device to confirm to the control point that access has been granted.

One skilled in the art would recognize the advantage of having the control point to confirm with the wireless device that access has been granted in order to start a demand session

of data-intensive application, to enable smooth online access to corporate data services or for roaming.

Laurila discloses wireless LAN access network architecture for mobile operators. The access controller-fig. 2 relays the authentication request to the authentication server-fig. 2. This fact inherently suggests that the wireless device has been confirmed that access has been granted prior to the authentication step to begin, see page 84- left column at the heading “authentication server”, see also fig. 4, page 86, right column.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Laurila with Eaton.

The suggestion/motivation for doing so would have been to start a demand session of data-intensive application, or to enable smooth online access to corporate data services, or for roaming.

Regarding claim 9, please see the rejection of claim 8. In Laurila a wireless device-fig 1 is able to report charges for usage of services through the WLAN to a billing service-fig. 2, see page 84, at the heading “authentication server” and the “access controller”.

Regarding claims 10-11, please see the rejection of claim 8. In Laurila the authentication server-fig. 2 is used for validating and authenticating the identity of the user of service before permitting access to the WLAN for services.

Regarding claim 12, in Eaton the portable device 100 is able to access to the Smart Network Access Point directly or indirectly via a WWAN for proximity to a WLAN from the location information 146-fig. 3.

Regarding claim 13, in Eaton the portable device 100 is able to access to the Smart Network Access Point directly or indirectly to a geo-location network for proximity to a WLAN from the location information 146-fig. 3.

Regarding claim 14, in Eaton the portable device 100 is able to use location information 120-fig. 2 to approximate proximity to a WLAN.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Puskala (US 2002/0165024); Angus (US 2002/0080008); Stuart et al. (US 2002/0101858) are cited to show managing wireless network data, which is considered pertinent to the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Friday from 7:00 am to 3:30 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2665

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

A handwritten signature in black ink, appearing to read "Duc Ho", written over the printed name.

Duc Ho

10-21-05